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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,077	01/08/2001	Wayne A. Provost	14689.10	6455

22913 7590 11/22/2005

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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,077

Applicant(s)

PROVOST ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12 April 2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 28 September 2005. Claims 1-27 and 36-39 are pending. Claims 28-35 are cancelled. Claims 1, 6, 9, 22-27, and 36 have been amended. The IDS statement filed 12 April 2001 has been entered and considered.

Claim Objections

2. The objections to claims 1 and 22 have been withdrawn due to the amendment filed 28 September 2005.

Claim Rejections - 35 USC § 112

3. The previous rejections of claims 1-27 and 36-39 under 35 USC § 112 are hereby withdrawn due to the amendment filed 28 September 2005.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 presently recites "distributing, by the financial entity, credit between a provider operational account that is accessible to a

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provider and a provider reserve account that is not accessible to the provider.” At pages 14-15 of Applicant’s specification, Applicant discloses that “the approved distribution funds are distributed between two accounts of a financial entity, such as a bank. The two accounts include a reserve account and an operational account.” It appears based on Applicant’s specification that these two accounts are actually accounts of the financial entity (i.e., financial entity operational account and financial entity reserve account). These accounts are not accounts of a provider as recited in claim 6. Thus, it appears that Applicant’s specification is inconsistent with the limitations recited in claim 6.

In addition, it is unclear how the provider reserve account is not accessible to the provider. If this account is an account of the provider (i.e., this account is in the provider’s custody), then how can this account not be accessible to him? It would appear that the provider should be able to access any account that is in his name, even if accessing that account includes receiving permission from an entity to access the account (i.e., a custodial account for a minor). It is also unclear how the credit is distributed between the two accounts. On what basis is the credit distributed?

Appropriate clarification of these issues is requested.

Claims 7-21 incorporate the deficiencies of claim 6, and are therefore rejected for the same reasons as claim 6.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al. (6,208,973).

(A) As per claim 1, Boyer discloses in a point of service third party adjudicated payment system including providers, an internet bank, a credit card network, and third party payors, a method for transferring funds to the provider in response to an insurance claim, and prior to the third party payor paying the claim comprising (Abstract, Fig. 1):

(a) receiving an insurance claim that included patient information (Patient ID), insurance information (Policy ID), and treatment information from the health care provider computer (Fig. 2A, 4, 7, col. 13 lines 8-41);

(b) adjudicating the insurance claim by an adjudication engine having a rules processor (22) (reads on "server") to determine whether a claim is eligible for third party payment (reads on "advance payment" because the third party payor reimburses the Internet bank, wherein the Internet bank paid for the portion owed by the third party payor) including determining whether the treatment is covered based on the insured's policy using a policy database, clinical pathways database, a provider network database

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and a standards database and verifying the patient's eligibility using a policy database and health history database (Fig. 2A-2B, 22, col. 8 lines to col. 9 line 67, col. 10 line 21 to col. 11 line 18, col. 12 lines 20-36, col. 13 lines 40-55, col. 14 line 45 to col. 15 line 18);

(c) sending the claim information from the adjudication engine associated with the insurance claim to the Internet bank, wherein the Internet bank executes a direct deposit of funds into the healthcare providers account, wherein this deposit is the healthcare provider receiving payment of the part of the healthcare transaction for which the patient is responsible (deductibles, copay, coinsurance), wherein this deposit occurs prior to the exchange between the Internet bank and third party payor regarding adjudication (note col. 10 lines 53-57) (col. 10 line 21 to col. 11 line 18); and

(d) exchanging information over the Internet between the Internet bank and the third party payor (healthcare administrator or insurance company), wherein the third party payor transfers the portion of the insurance claim it is obligated to pay to the healthcare provider's account via the Internet bank once the results of the claim adjudication are processed (col. 10 line 21 to col. 11 line 18).

(B) Claims 2-5 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action (dated 15 June 2005).

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-27 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al. (6,208,973) in view of Claimsnet.com (4/11/1997) and Official Notice.

(A) As per claim 6, Boyer discloses in a point of service third party adjudicated payment system including providers, an internet bank, a credit card network, and third party payors, a method for transferring funds to the provider in response to an insurance claim, and prior to the third party payor paying the claim comprising (Abstract, Fig. 1):

(a) receiving an insurance claim that included patient information (Patient ID), insurance information (Policy ID), and treatment information from the health care provider computer in an electronic claim form (Fig. 2A, 4, 7, col. 13 lines 8-41, col. 14 lines 22-44, col. 15 lines 19-34);

(b) transmitting the on-line claim through the Internet to the Internet bank, wherein the claim includes patient information (Patient ID), insurance information (Policy ID), and treatment information (Fig. 2A, 4, 7, col. 13 lines 8-41, col. 14 lines 3-53, col. 15 lines 19-34);

(c) adjudicating the insurance claim to determine whether a claim is eligible for third party payment (reads on "advance payment" because the third party payor

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reimburses the Internet bank, wherein the Internet bank paid for the portion owed by the third party payor) including determining whether the treatment is covered based on the insured's policy and verifying the patient's eligibility (col. 10 line 21 to col. 11 line 18, col. 12 lines 20-36, col. 13 lines 40-55, col. 14 line 45 to col. 15 line 18);

(d) transmitting claim information from the healthcare provider computer to the Internet bank, adjudication engine, and third party payor, where the adjudication engine (reads on "payment entity") identifies the healthcare transaction amount to be paid by the patient and the amount of the healthcare transaction to be paid by the third party payor and transmits the amount to the health care provider computer (Fig. 1, 7, col. 15 lines 1-6);

(e) sending the claim information (reads on "fund distribution request") from the adjudication engine (reads on "payment entity") associated with the insurance claim to the Internet bank (reads on "financial entity"), wherein the Internet bank executes a direct deposit of funds into the healthcare providers account, wherein this deposit is the healthcare provider receiving payment of the part of the healthcare transaction for which the patient is responsible (deductibles, copay, coinsurance), wherein this deposit occurs prior to the exchange between the Internet bank and third party payor regarding adjudication (note col. 10 lines 53-57) (col. 10 line 21 to col. 11 line 18); and

(f) distributing by the Internet bank, credit between a disbursement account and the third party payor's account or payment account (col. 11 lines 1-18, col. 16 lines 52-61).

Boyer fails to expressly disclose "wherein the insurance claim is revised at the client computer if the insurance claim is not eligible for advance payment until the remote server computer determines that the insurance claims is in condition for advance payment." However, Boyer discloses making final edits at the healthcare provider computer and then submitting the claim (col. 14 lines 22-45). Claimsnet discloses if any claims are missing or have incorrect information, the claimsnet.com service automatically lets the user know so they can make the appropriate corrections, wherein once the claims are corrected they are then sent to payors (par. 5 on pg. 2). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Claimsnet within the method of Boyer with the motivation of allowing a provider to determine, before services are rendered, whether they will be paid for the services (Boyer, col. 12 lines 57-67).

As per the recitation of "distributing credit between a provider operational account that is accessible to a provider and a provider reserve account that is not accessible to the provider," the Examiner respectfully submits that it is well known in the art to have accounts that are accessible to a user and accounts that are not accessible to a user. For example, Fleming provides for a system where there is a credit card account having a parent account and a child's account linked to the parent's account. The parent is able to determine how the account is used, such as by preventing the child from making any purchases, while the parent is able to make purchases. This is considered to be a form of an account where the user has access to the account (i.e., the parent) and no access to the account (i.e., the child) (Abstract; col. 3 line 5 to col. 4

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line 10, col. 11 lines 26-50). The motivation for including this well known feature of supervising accounts within the method of Boyer and Claimsnet being to ensure that a user does not overspend through a credit card and ensure there is available credit to cover a user's charges (Fleming; col. 2 lines 5-65).

(B) As per claims 7-9, 10, 12, 14, and 16-18, these claims repeat limitations from claims 2-6, and are therefore rejected for the same reasons as claims 2-6. Note the following teachings of Boyer with regards to this claims:

Boyer discloses receiving from the healthcare providers computer, while treating the patient, another insurance claim to be adjudicated that includes additional treatments, and determining whether the treatment is covered by the Internet bank or adjudicated third party payment system (col. 13 line 8 to col. 14 line 15).

Boyer discloses the adjudication engine identifying the healthcare transaction amount to be paid by the patient and the amount of the healthcare transaction to be paid by the third party payor and transmits the amount to the health care provider computer (Fig. 5-7, col. 15 lines 1-6).

Boyer discloses rejecting or accepting a claim through the healthcare provider web browser for payment by the third party payor and Internet bank (col. 13 lines 9-65, col. 15 lines 19-52).

Boyer discloses providing a healthcare bill from the Internet bank that identifies how much money the Internet bank will transfer to the healthcare provider (Fig. 5-7, col. 11 lines 1-18).

(C) As per claim 11, Boyer discloses the third party payor processing the claim after the Internet bank transmits the information to the third party payor (col. 10 line 22 to col. 11 line 34).

(D) As per claim 13, Boyer discloses the third party payor transferring the portion of the insurance claim that it is obligated to pay (col. 11 lines 1-18);

(E) As per claims 19-21, Boyer discloses providing information relating to the amount the third party payor is responsible for and the amount to be paid by the patient or co-payment to the health care provider computer, where the card holder (i.e. patient) reviews the bill at the health care providers office (Fig. 5-7, col. 2 lines 52-67, col. 14 line 45 to col. 15 line 34).

(F) Claim 22 has been amended to recite "revising the insurance claim by amending at least one of a diagnosis code or a treatment code" and "wherein the remote server computer provides said revised insurance claim to a payment entity that issues a fund distribution request to a financial entity prior to a carrier adjudicating the revised insurance claim." Boyer discloses making final edits at the healthcare provider computer and then submitting the claim (col. 14 lines 22-45). Boyer does not disclose amending the codes. Claimsnet discloses if any claims are missing or have incorrect information, the claimsnet.com service automatically lets the user know so they can

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make the appropriate corrections, wherein once the claims are corrected they are then sent to payors (par. 5 on pg. 2). The Examiner respectfully submits that making corrections to the claims includes editing diagnosis and treatment codes. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Claimsnet within the method of Boyer with the motivation of allowing a provider to determine, before services are rendered, whether they will be paid for the services (Boyer, col. 12 lines 57-67).

The remaining features of claim 22 are discussed in the rejection of claim 6 above, and thus claim 22 is rejected for the same reasons given in 6.

(G) Claim 23 and 25-27 are rejected for the same reasons given in claims 19-22, and incorporated herein.

(H) As per claim 24, Boyer discloses the CPT codes and diagnosis codes (Fig. 7, col. 9 lines 24-35).

(I) Claims 36 and 38-39 repeat the limitations of claims 6--9, 10, 12, 14, and 16-18 and 19-21, and is therefore rejected or the same reasons as those claims, and incorporated herein.

(J) As per claim 37, Boyer discloses entering data into an electronic claim form, such as patient information, insurance information, and treatment information (col. 14 lines 21-45).

Response to Arguments

10. Applicant's arguments filed 28 September 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below.

(A) In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 28 September 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Boyer, Claimsnet, and/or Fleming, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (15 June 2005), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

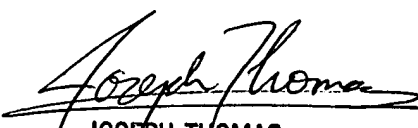
Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

November 14, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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